

REMARKS

Claims 11-15, 18, 20-22, 25, 26, 36, 37, 39-51, 54-59, 66-70, 74-83, 89-92, 102, 105-108, 111, 113-115, 118, 119, and 131-133, and 139-159 have been withdrawn from consideration. By this Amendment, claims 34, 127, and 143-159 have been canceled, without prejudice or disclaimer, claims 1, 40, 50, 57, 60, 81, 93, 104, 113, 114, 117, 118, 128, and 130 have been amended, and claims 160 and 161 have been newly added.¹ Consequently, claims 1-33, 35-126, 128-142, 160, and 161 are pending in the application. No new matter has been entered by this Amendment.

As an initial matter, Applicant respectfully notes that the Office Action lacks a clear indication of the status of claim 128. Although claim 128 was apparently indicated as being rejected in the Office Action Summary², the claim was not subject to any rejections in the Office Action. Thus, Applicant presumes that claim 128 contains allowable subject matter and should be allowable if rewritten in independent form. Accordingly, Applicant has rewritten claim 128 in independent form to place the claim in condition for allowance. (If the Examiner intended a rejection of that claim, Applicant respectfully requests that the Examiner set forth a detailed explanation of the basis for that rejection and make any subsequent Office Action non-final to provide Applicant with a full and fair opportunity to respond.)

Claims 1-4, 6-10, 16, 19, 23, 24, 30-32, 34, 35, 38, 53, 60-65, 71-73, 84-88, 93-96, 98-101, 103, 104, 109, 112, 116, 117, 123-125, 127, 130, and 134-138 were

¹ New claims 160 and 161 are "readable" on the previously elected species.

² The list of claims identified in item 7) of the Office Action Summary appears to have been intended for item 6) of the Summary.

rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,752,147 to Persi. As explained below, Applicant respectfully submits that this rejection should be withdrawn.

Independent claim 1 recites, among other things, “at least one receptacle ... comprising a housing” and “a removable unit defining a substantially enclosed space and ... being configured to be removed from the housing while the unit defines the substantially enclosed space.” Independent claim 60 recites, among other things, a removable unit “being configured to be removed from [a housing of a receptacle] while the unit defines the substantially enclosed space.” Each of new independent claims 160 and 161 recites, among other things, a removable unit “being configured to be removed from [a] receptacle while the unit defines the substantially enclosed space.” Independent claim 93 recites, among other things, a removable unit “comprising a first portion ... and a second portion ...” and “the first portion being configured to be removed from [a] housing together with the second portion in [a] closed position.”

Persi discloses a fluid applicator 10 having a fluid containing jar 12 and a lid 14 insertable into the open top of the jar 12. A perforated plate 26 is screwed onto the interior surface of the jar 12 near its top, and an applicator sponge 48 is attached to the lid 14, as best shown in Fig. 4. The Examiner asserted that the perforated plate 26 corresponds to the recited “removable unit.” Applicant respectfully disagrees with this assertion.

Persi does not to disclose, teach, or suggest, among other things, the above-mentioned recitations of claims 1, 60, 93, 160, and 161. For example, as is abundantly clear, the plate 26 of Persi cannot be construed as corresponding to the recited

“removable unit defining a substantially enclosed space,” because the plate 26 alone cannot define an enclosed space. Rather, the plate 26 must be in place with the lid 14 in a closed state (shown in Fig. 2) to define any space therebetween.

Even if the Examiner is asserting that a combination of the plate 26 and the lid 14 could be considered to be a unit defining an enclosed space, that combination is not configured to be removed from a housing or receptacle “while the unit defines the substantially enclosed space,” as recited in independent claims 1, 60, 160, and 161. Moreover, the plate 26 and the lid 14 do not correspond to the first and second portions recited in claim 93, because there is no “first portion being configured to be removed from [a] housing together with the second portion in [a] closed position.”

As best shown in Fig. 4, the plate 26 and the lid 14 must be separately removed from the jar because the plate 26 is screwed onto the inner surface of the jar 12 and the lid 14 is placed on the top of the jar 12. That is, the plate 26 cannot be removed from the jar 12, unless the lid 14 is separately removed beforehand. Consequently, regardless of what sort of a space there may be defined by the plate 26 and the lid 14, the plate 26 and the lid 14 cannot be removed from the jar 12 while defining that space. Therefore, the combination of the plate 26 and the lid 14 cannot be construed as corresponding to the recited “removable unit being configured to be removed from the housing [or receptacle] while the unit defines the substantially enclosed space” of independent claims 1, 60, 160, and 161. Similarly, neither the plate 26 nor the lid 14 can be construed as corresponding to the recited “first portion being configured to be removed from the housing together with the second portion in the closed position” of independent claim 93.

For at least this reason, independent claims 1, 60, 93, 160, and 161 are patentably distinguishable from Persi.

With respect to independent claim 61 and dependent claims 62-65, 71-73, 84-88, and 134-138, the Examiner asserted that the “method for loading an application device is inherently performed during the normal operation of the [Persi’s] device.” Applicant respectfully disagrees with the Examiner’s assertion because the Examiner has improperly relied on an inherency position.

In order to rely on a position of inherency, the Examiner must provide a factual basis and/or technical reasoning to reasonably support his/her determination that the allegedly inherent element or characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); In re Schreiber, 128 F.3d 1473 (Fed. Cir. 1997). A method claim, in particular, can be considered to be anticipated by the prior art device only if the prior art device, in its normal and usual operation, would necessarily perform the claimed method. See MPEP § 2112.02.

In this case, independent claim 61 recites, among other things, “selecting at least one receptacle from a plurality of receptacles containing differing products” and “positioning the removable unit on the at least one selected receptacle.” The Examiner, however, failed to provide any factual basis or technical reasoning to support his apparent assertion that the above-mentioned “selecting” and “positioning” features are necessarily performed during normal operation of Persi’s device. In fact, the Examiner did not even identify what constitutes the normal and usual operation of Persi’s device.

The Examiner’s inherency assertion is clearly based on improper hindsight

reasoning, together with an apparent misunderstanding of the requirements for an inherency-based rejection. Not only is an unsupported assertion of the possibility that the Persi's device could be used to perform the above-mentioned "selecting" and "positioning" insufficient to establish inherency, but also such hindsight reasoning is not a permissible interpretation of the teachings of the reference. The Examiner must read the reference without the hindsight gained from Applicant's disclosure and, when read this way, it becomes abundantly clear that the above-mentioned features of independent claim 61 are not necessarily performed during the normal and usual operation of the Persi's device.

For at least these reasons, independent claim 61 is patentably distinguishable from Persi.

For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Persi.

Claims 1-4, 6-10, 16, 17, 19, 23, 24, 30-32, 34, 35, 38, 52, 53, 60-65, 71-73, 84-88, 93-101, 103, 104, 109, 110, 112, 116, 117, 123-125, 127, 129, 130, and 134-138 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,311,367 to Chambers ("Chambers"). As explained below, Applicant respectfully submits that this rejection should be withdrawn.

Independent Claims 1, 60, and 93

Independent claim 1 recites, among other things, "at least one receptacle ... comprising a housing," "a removable unit ... not including a dip tube," and "at least part of the removable unit being configured to be removably received in the housing." Similarly, each of independent claims 60 and 93 recites, among other things, "a

removable unit ... not including a dip tube” and “at least part of the removable unit being configured to be removably received in a housing of a receptacle.” As will be detailed below, Chambers fails to disclose, teach, or suggest, among other things, the above-mentioned structural recitations of claims 1, 60, and 93.

Chambers discloses device for withdrawing liquid L from a bottle 4. As shown in, for example, Figs. 4-6, the device includes a bulb 15 having a neck portion 17 that is fit around a neck 3 of the bottle 4. A hollow dip tube 18, having its upper portion tightly joined with the bulb neck 17, projects from the bulb 15 into the bottle 4. In the rejection statement, the Examiner asserted that the bulb 15 of Chambers corresponds to the recited “removable unit” and that, with respect to claims 34 and 127, the neck 2 or bottle 4 corresponds to the recited “housing.” The Examiner then asserted that, with respect to claim 34, the neck 2 is “configured to receive the part 17 of the removable unit 15” and that, with respect to claim 127, the bottle 4 is “configured to receive at least part of the removable unit.”

Applicant respectfully disagrees with the Examiner’s assertions. In particular, Applicant respectfully submits that the Examiner has misinterpreted the teachings of Chambers with respect to the engagement relationship between the bottle 4 and the bulb 15. For example, as clearly shown in the figures and described in the specification (e.g., page 1, left-hand column, lines 42-45; and page 1, right-hand column, lines 54-55), the neck portion 2, 17 of the bulb 1, 15 is “adapted to receive and closely engage the neck 3 of a bottle 4.” In other words, it is the neck of the bulb, rather than the neck of the bottle, that is configured to receive the neck of the bottle. Thus, no part of the bulb 1, 15 in Chambers is “configured to be removably received in [a] housing,” as

recited in independent claims 1, 60, and 93.

For at least this reason, independent claims 1, 60, and 93 are patentably distinguishable from Chambers.

Although unclear, the Examiner may have asserted that the hollow dip tube 5, 18 of Chambers is part of the bulb 1, 15, and based on such an assertion, the Examiner may have further asserted that the bulb 1, 15 may be considered as being removably received in the bottle 4 due to the dip tube 5, 18 being a part thereof. Applicant submits that each of independent claims 1, 60, and 93 now recites “a removable unit not including a dip tube.” Therefore, regardless of whether the Examiner considered the dip tube 5, 18 of Chambers as being part of the bulb 1, 15, the dip tube 5, 18 can no longer be construed as being part of the “removable unit” recited in claims 1, 60, and 93.

Independent Claim 61

In the rejection statement, identical to the reason set forth in the 35 U.S.C. § 102(b) rejection based on Persi above, the Examiner asserted that the “method for loading an application device is inherently performed during the normal operation of the [Chambers]’ device.”

For reasons similar to those set forth above, Applicant respectfully submits that the rejection of independent claim 61 should be withdrawn because the Office Action does not set forth a proper inherency-based rejection. In particular, the Office Action fails to establish that the normal and usual operation of the device of Chambers would necessarily perform all of the subject matter of claim 61.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Chambers.

New Independent Claim 160

New independent claim 160 recites, among other things, “a removable unit defining a substantially enclosed space and being rigid such that the substantially enclosed space does not have a variable volume.” As explained below, Chambers fails to disclose, teach, or suggest, among other things, the above-mentioned recitation of independent claim 160.

As discussed on page 1 of Chambers (e.g., left-hand column, lines 54 - right-hand column, line 3), the bulb 1, 15 of Chambers is “formed of flexible material such as vulcanized rubber which is readily deformable and possesses resiliency to return quickly to normal position when relieved from deforming pressure.” In addition, to withdraw liquid L from the bottle 4, the bulb 1, 15 is deformed, for example, from the position shown in Figs. 1, 4 to the position shown in Figs. 2, 5, reducing the volume of bulb 1, 15 to force the air in the bulb 1, 15 to flow to the bottle 4. Upon release of pressure on the bulb 1, 15, the bulb returns to its normal position, as shown in Figs. 3, 6, to force the liquid into the bulb 1, 15 from the bottle 4.

As is abundantly clear, therefore, Chambers fails to disclose, teach, or suggest, among other things, “a removable unit defining a substantially enclosed space and being rigid such that the substantially enclosed space does not have a variable volume.” For at least this reason, Applicant respectfully submits that independent claim 160 is patentably distinguishable from Chambers.

New Independent Claim 161

New independent claim 161 recites, among other things, “a removable unit comprising a first portion and a second portion configured to be releasably connected together to define a substantially enclosed space.” As explained below, Chambers fails to disclose, teach, or suggest, among other things, that recitation of independent claim 161.

In the rejection statement, the Examiner asserted that, with reference to Figs. 4-6 of Chambers, the bulb 15 corresponds to the recited “first portion” and the handle 20 corresponds to the recited “second portion.” The Examiner then asserted that, with respect to claim 4, the bulb 15 and the handle 20 are removably engageable with one another.

Without accepting the Examiner’s assertions, Applicant respectfully submits that the bulb 15 and the handle 20 are not “releasably connected together to define the substantially enclosed space,” as recited in independent claim 161. Instead, the handle 20 having a flanged portion 21 with a flexible edge 22 is merely placed on the top of the bulb 15 to cover an aperture 19 and to seal the bulb only when the handle 20 is pressed downwardly. See, e.g., page 2, left-hand column, lines 2-10, of Chambers.

For at least this reason, Applicant respectfully submits that independent claim 161 is patentably distinguishable from Chambers.

Claims 60-65, 71-73, 84-88, and 134-138 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,534,259 to Dempsey (“Dempsey”). As explained below, Applicant respectfully submits that this rejection should be withdrawn.

As an initial matter, Applicant believes that the rejection of claims 134-138 is erroneous inasmuch as these claims depend from independent claim 93, which was not subject to this rejection based on Dempsey. Applicant respectfully requests that the Examiner remove claims 134-138 from this rejection or clarify this matter in the next Office communication to Applicant.

As detailed above in the discussion of 35 U.S.C. § 102(b) rejection based on Persi, independent claim 60 recites, among other things, a removable unit “defining a substantially enclosed space” and “being configured to be removed from the housing while the unit defines the substantially enclosed space.” New independent claims 160 and 161 include similar recitations.

Dempsey discloses a polishing device having a receptacle 1, an inner cover 3 screwed onto a threaded neck 2 of the receptacle 1, and a cover 10 that can be screwed onto the inner cover 3. Dempsey fails to disclose or suggest, among other things, a removable unit “defining a substantially enclosed space” and “being configured to be removed from the housing while the unit defines the substantially enclosed space,” as recited in independent claim 1.

In the rejection statement, the Examiner asserted that the inner cover 3 corresponds to the recited “removable unit.” Applicant respectfully submits that the inner cover 3 alone cannot correspond to the recited “removable unit” because the inner cover 3 cannot alone define a substantially enclosed space.

Moreover, even if the Examiner were to assert that the inner cover 3 combined with the cover 10 somehow relates to a removable unit, such a combination still cannot be construed to correspond to the “removable unit” of claims 60, 160, and 161 because

the inner cover 3 and the cover 10 are not “configured to be removed from the housing while the unit defines the substantially enclosed space.” Instead, the cover 10 and the inner cover 3 must be separately removed from the receptacle one by one, as shown in Fig. 2 of Dempsey, and, therefore, the cover 10 and the inner cover 3 cannot maintain a substantially enclosed space while being removed from the receptacle 1. For example, as clearly shown in Fig. 1, the cover 10 is screwed onto the outer surface of the inner cover 3, such that the cover 10 encloses substantially the entire outer surface of the inner cover 3. Consequently, without separately removing the cover 10 beforehand, the inner cover 3 cannot be removed from the receptacle 1.

For at least this reason, independent claims 60, 160, and 161 are patentably distinguishable from Dempsey.

With respect to independent claim 61 and dependent claims 62-65, 71-73, 84-88, and 134-138, the Examiner asserted that “method for loading an application device is inherently performed during the normal operation of the [Dempsey’s] device.” Applicant respectfully disagrees with the Examiner’s inherency assertion because the Office Action fails to establish that the normal and usual operation of the device of Dempsey would necessarily perform all of the subject matter of claim 61. For this reason, Applicant respectfully submits that the rejection of independent claim 61 based on Dempsey should be withdrawn.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) based on Dempsey.

Claims 27-29 and 120-122 were rejected under 35 U.S.C. § 103(a) as being unpatentable over either Persi in view of U.S. Patent No. 6,309,124 to Gueret

("Gueret"), or Dempsey in view of Persi and further in view of Gueret.

Claims 27-29 depend from independent claim 1, and claims 120-122 depend from independent claim 93. As discussed above, independent claims 1 and 93 are patentably distinguishable over Persi and Dempsey. Gueret does not cure the deficiency of Persi and Dempsey. Thus, at least by virtue of their dependencies from allowable claims 1 and 93, Applicant respectfully submits that claims 27-29 and 120-122 should be allowable. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a) based on Dempsey, Persi, and Gueret.

Claims 1-8, 16, 17, 19, 23, 24, 30, 32-35, 38, 52, 53, 93-99, 109, 110, 116, 117, 123-127, 129, and 130 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dempsey in view of Persi.

Relevant disclosures of Dempsey and Persi and their deficiencies with respect to the claims are discussed in detail above. For example, as discussed above, both Dempsey and Persi fail to disclose, among other things, a removable unit being configured to be removed from the housing (or receptacle) while the unit defines the substantially enclosed space, as recited in each of independent claims 1, 60, 160, and 161, or a removable unit comprising a first portion and a second portion where the first portion is configured to be removed from the housing together with the second portion in the closed position, as recited in independent claim 93.

Therefore, even if the alleged teachings of Dempsey and Persi were somehow combined, such a combination still cannot render the claimed invention obvious because the combination fails to teach or suggest each and every element of the

claimed invention. For at least this reason, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a) based on Dempsey and Persi.

Since generic claims 1, 60, 61, and 93 are allowable, Applicant respectfully requests that claims 11-15, 18, 20-22, 25, 26, 36, 37, 39-51, and 54-59 (which depend from allowable independent claim 1), claims 66-70 (which depend from allowable independent claim 61), claims 81-83 and 89-92 (which depend from allowable independent claim 60), and claims 102, 105-108, 113-115, 118, 119, 131-133, and 139-142 (which depend from allowable independent claim 93), all of which had been withdrawn from consideration, be rejoined in this application and be allowed at least by virtue of their dependency from allowable independent claims 1, 60, 61, and 93.

Applicant takes this opportunity to thank the Examiner for reconsidering the prior election of species requirement and rejoining claims 60-65, 71-73, 84-88, and 134-138 in the application for consideration. Applicant respectfully submits, however, that at least independent claim 74 should be additionally rejoined in the application for the following reason.

In response to Applicant's remarks filed on September 30, 2003, the Examiner asserted that,

[t]he removable units of Figures 1-3 and 5 are shown in combination with specific receptacles. These removable units are different from the removable units shown in Figures 10, 14, 15, 16, 19, 20, 24, and 25. For the removable unit in Figures 1-3 and 5 used in combination with the receptacles of Figures 10, 14, 15, 16, 19, 20, 24, and 25, these removable units would require different structures compliment with various types of receptacle shown.

Applicant respectfully disagrees with the Examiner's reasoning. For example,

contrary to the Examiner's assertion, Applicant respectfully submits that the removable unit shown in Figs. 1-3 and 5 can be readily used in combination with the receptacles shown in, for example, Figs. 14, 15, 16, 19, 20, 24, and 25 without necessarily requiring a substantive change (or possible without any change) to the structure of the removable unit. In particular, there is no reason why one of ordinary skill in the art would not be able to use the removable unit of Figs. 1-3 and 5 with a receptacle shown in Fig. 24 or 25.

The Examiner appears to allege that the removable unit 300 of Figs. 24 and 25, although not shown in detail, requires a structure that is different from Figs. 1-3 and 5. Applicant respectfully disagrees.

Moreover, there is no explanation of why claims 61-80, 84-92, and 134-142 were withdrawn from consideration despite the fact that the methods recited in those claims could be performed using subject matter shown in Figs. 1-3 and 5.

For at least these reasons, Applicant respectfully submits that at least claims 61-80, 84-92, and 134-142 should be rejoined to this application and examined.

Applicant respectfully requests the reconsideration of this application, the withdrawal of all the outstanding rejections, and the allowance of all of the pending claims.


The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to subscribe automatically to any statement or characterization in the Office Action, regardless of whether it is addressed above.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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